

## **REMARKS**

Applicants respectfully request reconsideration of the newly presented rejections of the claims of the instant application in view of the above-mentioned amendments and the following remarks.

### **II. AMENDMENTS TO THE SPECIFICATION**

The specification as originally filed has been amended to correct for various editorial oversights with respect to the serial numbers of various foreign patent applications cited in the background section of the specification. No new matter is presented.

### **II. STATUS OF THE CLAIMS**

Claims 17-22 and 25-30 are presently pending and under consideration. Claims 23 and 24 have been withdrawn. Applicants reserve the right to file a divisional or continuing application on any non-pursued subject matter. Claims 17, 26, and 30 are currently amended. Specifically, claims 17 and 30 are amended to recite a method for the inhibition of melanin synthesis in skin and/or hair. Support for these amendments is provided in the originally filed specification at least at page 3, lines 21-22, and page 38, line 6 through page 39, line 6. Claims 26 and 30 are amended to correct for a minor editorial oversight; specifically, to recite that the sugar esters have an average degree of esterification of 1.5 to 2.5. Support for these amendments is provided in the originally filed specification at least at page 6, lines 27-29. No new matter is presented. No new claims are added.

### **III. SUMMARY OF THE INVENTION AS CLAIMED**

The presently claimed invention is directed to a method for inhibiting the synthesis of melanin in skin and/or hair comprising: (a) providing a composition comprising a sugar ester; and (b) contacting a substrate selected from the group consisting of skin and hair with the composition in an amount effective to inhibit the synthesis of melanin, whereby the ability of the skin or hair to synthesize melanin is inhibited.

#### **IV. REJECTIONS UNDER 35 U.S.C. § 102(b) AND 103(a)**

Claims 17-19, 21, and 25-26 were rejected under 35 U.S.C. § 102(b) as anticipated by Handa et al. (EP 0343671) as evidenced by Jaspers et al. (JAOCS, Vol. 64, no. 7, July 1987, pp. 1020-1025). Claims 20, 22, and 27-30 were rejected under 35 U.S.C. § 103(a) as obvious over Handa et al. as evidenced Jaspers et al. Handa et al. is related to compositions for the external treatment of skin wounds, such as pressure sores. The Examiner states that Handa et al. disclose compositions comprising 2-40% by weight of a fatty acid ester and a prophylactically effective amount of an antiinfective. The Examiner cites to example 5 disclosed in Handa et al., which discloses a composition comprising DK Ester F-160, and states that this ester has an average degree of esterification of approximately 1.23-1.46 as evidenced by Jaspers et al.

Applicants respectfully traverse these rejections at least because Handa et al. does not disclose or suggest a method of inhibiting the synthesis of melanin in skin or hair comprising applying a composition comprising a sugar ester in an amount effective to inhibit the synthesis of melanin, as recited by the claims as presently amended. Although Applicants do not necessarily agree with the Examiner's characterizations of Handa et al., in order to further the prosecution of this application the claims have been amended in a way which moots the Examiner's rejections. Handa et al. is directed to the treatment of skin wounds such as pressure sores. In contrast, the presently claimed invention recites, among other aspects, a method of inhibiting melanin synthesis comprising the application of a composition comprising an effective amount of sugar ester to skin or hair. Therefore, Applicants' claims as presently amended recite subject matter that is novel and unobvious over Handa et al.

Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.

#### **V. PROVISIONAL NONSTATUTORY OBVIOUSNESS-TYPE DOUBLE PATENTING**

Claims 17-18 and 21 have been provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-7 of copending U.S. App. No. 12/294,203. Although Applicants disagree with the double

patenting rejection, Applicants will consider filing a terminal disclaimer if the above-mentioned claims are otherwise found to be allowable.

### **CONCLUSION**

In view of the abovementioned amendments and remarks, Applicants respectfully assert that this application is now in condition for allowance. The Examiner is invited to contact the undersigned counsel in order to further the prosecution of this application in any way.

Respectfully submitted,

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